

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kamen et al.

Application No.: 10/617,608

Filed: July 11, 2003

For: Motion Control of a Transporter

Group No.: 3611

Examiner: Luby, M.

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL OF SECOND SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT BEFORE MAILING DATE OF EITHER A FINAL ACTION
OR NOTICE OF ALLOWANCE (37 C.F.R. § 1.97(c))TIME OF TRANSMITTAL OF ACCOMPANYING
INFORMATION DISCLOSURE STATEMENT

1. The information disclosure statement transmitted herewith is being filed *after* three months of the filing date of this national application or the date of entry of the national stage as set forth in Section 1.491 in an international application or after the mailing date of the first Office action on the merits, whichever event occurred last but *before* the mailing date of either
- (1) a final action under § 1.113 or
 - (2) a notice of allowance under § 1.311

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using *Express Mail*, the *Express Mail* label number is *mandatory*;
Express Mail certification is *optional*.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

[x] deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)

[x] with sufficient postage as first class mail.

37 C.F.R. § 1.10*

☐ as "Express Mail Post Office to Addressee"

Mailing Label No. _____ (mandatory)

TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office, (703) _____

Signature

Alexander J. Smolenski, Jr., Esq.

(type or print name of person certifying)

Date: February 24, 2005

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

whichever occurs first.

CHOOSE ONE:

STATEMENT

2. ☒ Accompanying this transmittal is a statement as specified in 37 C.F.R. section 1.97(e).

OR

FEE

2. Accompanying this transmittal is the fee for submission of an information disclosure statement under section 1.97(c). (\$180.00)

FEE PAYMENT

3. Applicant elects the option to pay the fee set forth in 37 C.F.R. § 1.17(p) for submission of an information disclosure statement under § 1.97(c) (\$180.00).

Fee due \$180.00

METHOD OF PAYMENT OF FEE

4. Attached is a check in the amount of \$180.00 OR Authorization is hereby made to charge the amount of \$180.00 to Deposit Account No. 19-4972.

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

DATE: February 24, 2005



Alexander J. Smolenski, Jr., Esq.
BROMBERG & SUNSTEIN LLP
125 Summer Street
Boston, MA 02110-1618
US

1062/D67 366275



Practitioner's Docket No. 1062/D67

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kamen et al.

Group No.: 3611
Examiner: Luby, M.

Application No.: 10/617,608

Filed: July 11, 2003

For: Motion Control of a Transporter

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT FOR SECOND SUPPLEMENTAL INFORMATION DISCLOSURE UNDER 37
C.F.R. SECTION 1.97(e)

NOTE: A statement must state either: "(1) that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement." 37 C.F.R. Section 1.97(e).

NOTE: "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. SECTION 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being:

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Date: February 24, 2005

Signature

Alexander J. Smolenski, Jr., Esq.

a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19.

NOTE: "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of Section 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications, even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

NOTE: A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: "The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 C.F.R. 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an information disclosure statement without a fee" in a certification procedure under Section 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).

NOTE: The mere absence of an item of information for a foreign patent office communication is not intended to represent an opportunity to delay the submission of a item known more than three months prior to the filing of an information disclosure statement to an individual having the duty of disclosure under Section 1.56. 62 Fed. Reg. 53,131, 53,150 (Oct. 10, 1997).

NOTE: "The certification under Section 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.

NOTE: "The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 C.F.R. Section 1.56(d) and

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) each inventor named in the application;

(2) each attorney or agent who prepares or prosecutes the application; and

(3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. Section 1.56(c).

**IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT
FOR WHICH THIS STATEMENT IS BEING MADE**

1. This statement is being made for the Information Disclosure Statement

☒ accompanying this statement.

☐ filed _____
Date

STATEMENT

2. I, the person(s) signing below state:

☒ that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(1).

NOTE: The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

OR

☐ that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(2).

NOTE: "The time at which information 'was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT

3. The person making this statement is

(check each applicable item)

(a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

(b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. Section 1.56(c)) and who signs below.

SIGNATURE OF PERSON MAKING STATEMENT

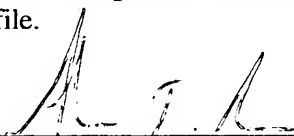
(type name of person who is signing)

Address of person who is signing

(c) ☒ the practitioner who signs below on the basis of the information:

(check each applicable item)

- ☐ supplied by the inventor(s).
☐ supplied by an individual designated in Section 1.56(c).
☒ in the practitioner's file.



SIGNATURE OF PRACTITIONER

Alexander J. Smolenski, Jr., Esq.

(type or print name of practitioner)

Bromberg & Sunstein LLP

125 Summer Street

P.O. Address

Boston, MA 02110-1618

Reg. No. 47,953

Tel. No. (617) 443-9292

Customer No.: 002101

1062/D67 366284

Practitioner's Docket No. 1062/D67 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application
of _____

for _____ Inventor(s)

Title of invention

the specification of which is being transmitted herewith

OR

In re application of: Kamen et al.

Application No.: 10/617,608

Group No.: 3611

Filed: July 11, 2003

Examiner: Luby, M.

For: **Motion Control of a Transporter**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

(Information Disclosure Statement--page 1 of 14)

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;

Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. SECTION 1.8(a)

37 C.F.R. SECTION 1.10*

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TRANSMISSION

☐ transmitted by facsimile to the Patent and Trademark Office.

Signature

Date: February 24, 2005

Alexander J. Smolenski, Jr., Esq.

***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. section 1.10(b).
"Since the filing of correspondence under section 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable C.F.R.e, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

NOTE: "An information disclosure statement shall be considered by the Office if filed by the applicant:
(1) Within three months of the filing date of a national application;
(2) Within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or
(3) Before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).

NOTE: "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. section 1.56(a).
"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
(1) each inventor named in the application;
(2) each attorney or agent who prepares or prosecutes the application; and
(3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. section 1.56(c).

NOTE: The "duty as described in section 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by sections 1.97(b) - (d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13-25 at 17.

WARNING: "No information disclosure statement may be filed in a provisional application." 37 C.F.R. section 1.51(b).

List of Sections Forming Part of This Information Disclosure Statement

The following sections are being submitted for this Information Disclosure Statement:

(check sections forming a part of this statement: disC.F.R.d unused sections and number pages consecutively)

1. ☒ Preliminary Statements
2. ☒ Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)
3. ☐ Statement as to Information Not Found in Patents or Publications
4. ☐ Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5. ☐ Cumulative Patents or Publications
6. ☒ Copies of Listed Information Items Accompanying This Statement
7. ☐ Concise Explanation of Non-English Language Listed Information Items
 - 7A. ☒ EPO Search Report
 - 7B. ☐ English Language Version of EPO Search Report
8. ☐ Translation(s) of Non-English Language Documents
9. ☐ Concise Explanation of English Language Listed Information Items (Optional)
10. ☒ Identification of Person(s) Making This Information Disclosure Statement

(complete the following, if appropriate)

Sections _____, respectively, have been continued on ADDED PAGE(S).

NOTE : "Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).

Section 1. Preliminary statements

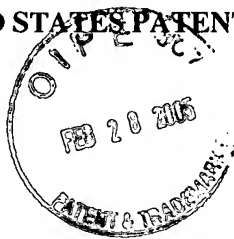
Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. section 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

SECTION 2. FORMS PTO/SB/08A and 08B (formerly Form PTO-1449)**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Kamen et al. Attorney Docket: 1062/D67
Serial No: 10/617,608 Art Group Unit: 3611
Date Filed: July 11, 2003 Examiner Name: Luby, M.
Invention: Motion Control of a Transporter

**LIST OF PATENTS AND PUBLICATIONS FOR
APPLICANT'S SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

U.S. PATENT DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Issue Date	Inventor	Class/Subclass
	GX	US 2004/0016584 A1	Jan. 29, 2004	Kamen et al.	180/218

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Reference Number	Country Code	Document Number	Publication Date	Patentee or Applicant	Class/Subclass
	GY	DE	102 09 093 A1	18 Sep. 2003	MS. Handelsvertretung et al.	B62M 7/10

OTHER DOCUMENTS			
Examiner Initials	Reference Number	Author	Title of Article, Title of Journal, Volume Number, Page Numbers, Date
	GZ		International Search Report dated January 7, 2005

Examiner Signature: _____

Date Considered: _____

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation *if not* in conformance and not considered. Include copy of this form with next communication to applicant.

Section 6. Copies of Listed Information Items Accompanying This Statement

NOTE: 37 C.F.R. section 1.98(a)(2) requires that any information disclosure statement filed under section 1.97 shall include: "A legible copy of: (1) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included . . ."

NOTE: The wording in section 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.

Legible copies of all items listed in Forms PTO/SB/08A and 08B (substitute for Form PTO-1449) accompany this information statement.

(complete the following, if applicable)

☒ Exception(s) to above:

☐ Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.

☐ Cumulative patents or publications identified in Section 5.

U.S. patent citations are not included pursuant to the United State Patent and Trademarks Office's September 21, 2004 waiver of the copy requirement in 37 CFR 1.98 for cited pending U.S. patent citations when the patent citations are available in the USPTO's IFW system.

Section 7A. Concise Explanation of Non-English Language Listed Information Items—EPO Search Report

The relevance with respect to the following citations listed on Forms PTO/SB/08A and 08B (substitute for PTO-1449):

is submitted on the basis of the accompanying:

(check the appropriate item)

☒ EPO search report that is in the English language,

☐ EPO search report that is not in the English language and that is accompanied also by an English language version of the EPO search report,

that issued on the corresponding European patent application.

Section 10. Identification of Person(s) Making This Information Disclosure Statement

The person making this certification is

(check each applicable item)

(a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

(b) ☐ an individual associated with the filing and prosecution of this application (37 C.F.R. section 1.56(c))

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

(c) ☒ the practitioner who signs below on the basis of the information:

(check each applicable item)

☐ supplied by the inventor(s).

☐ supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. section 1.56(c)).

☒ in the practitioner's file.



SIGNATURE OF PRACTITIONER

Alexander J. Smolenski, Jr., Esq.

(type or print name of practitioner)

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P.O. Address

Boston, MA 02110

Reg. No.: 47,953

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Customer No.: 002101

1062/D67 366197